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EXAMINER

SAADAT, CAMERON

ART UNIT PAPER NUMBER

3713

DATE MAILED: 03/25/2004

11

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/812,472

Applicant(s)

JELINEK, LENKA M.

Examiner

Cameron Saadat

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 December 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

In view of the Appeal Brief filed on 12/29/03, PROSECUTION IS HEREBY REOPENED in view of the new grounds of rejection set forth below. Claims 1-32 are pending in this application.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-2, 5-8, 14-18, 20-21, 23, 25, 27, 29, and 31 are rejected under 35

U.S.C. 102(e) as being anticipated by Shackelford (USPN 6,227,931 B1).

Regarding claim 1, Shackelford discloses a toy set comprising: a panel having a first surface, the first surface adapted to simulate a wall to use with a toy figurine; and a first display 93 that is to be attached to the first surface (Col. 11, lines 37-39), the first display adapted to receive a first set of image data, and to display a first image responsive to the first set of image data, wherein the image data is distinct from the wall simulated on the first surface of the panel (Col. 14, lines 17-20).

Regarding claim 25, Shackelford discloses an article comprising: a storage medium 90 comprising instructions such that, when executed by at least one device, result in: waiting to receive a signal output from a detector indicative of a toy figurine characteristic; and if the signal is received, transmitting a first set of image data to a display associated with a panel to cause

the display to display an image corresponding to a first set of image data, wherein the panel is adapted to provide a first surface which simulates a wall to use with the toy figurine and the image data is distinct from the wall simulated on the first surface of the panel (Col. 14, lines 17-52; Col. 11, lines 37-39).

Regarding claim 29, Shackelford discloses a method comprising: providing a panel having a first surface which simulates a wall to use with a toy figurine; waiting to receive an output of a detector about a location of the toy figurine; and if the output is received, transmitting a first set of image data to a display associated with the panel to cause the display to display an image corresponding to the first set of image data, wherein the image data is distinct from the wall simulated on the first surface of the panel (Col. 14, lines 17-52; Col. 11, lines 37-39).

Regarding claim 2, Shackelford discloses a toy set, wherein the panel has a data connection allowing the display 93 to receive image data from controller 90 (See Fig. 5, Fig. 14).

Regarding claim 5, Shackelford discloses a method, wherein the first set of image data is derived from a global computer network (see Fig. 14).

Regarding claims 6, 27, and 31 Shackelford discloses a toy set, wherein the first set of image data is one of a plurality of sets stored in a memory (See Col. 14, lines 17-19).

Regarding claim 7, Shackelford discloses a toy set, further comprising: a toy figurine having a theme related to a theme of the first image (See Col. 14, lines 17-19).

Regarding claim 8, Shackelford discloses a toy set, further comprising a stand-alone controller 90 to transmit the first set of image data to the first display 93.

Regarding claim 14, Shackelford discloses a toy set, wherein the display includes a screen (See Fig. 14, ref. 93).

Regarding claim 15, Shackelford discloses a toy set, wherein the screen is a liquid crystal display screen (See Fig. 14, ref. 93).

Regarding claim 16, Shackelford discloses a toy set, further comprising: a light source 39, 44, 50 (See Col. 10, lines 38-43).

Regarding claim 17, Shackelford discloses a toy set, further comprising: a speaker (See Fig. 5, ref. 92).

Regarding claim 18, Shackelford discloses a toy set, further comprising: a detector, wherein the first set of image data is responsive to an output of the detector (Col. 14, lines 17-52)).

Regarding claim 20, Shackelford discloses a toy set, further comprising: a lamp 39, 44, 50, wherein the lamp is controlled responsive to an output of the detector (See Col. 10, lines 37-46).

Regarding claim 21, Shackelford discloses a toy set, wherein the detector is to detect one of a location or an identity of the toy figurine (See Col. 10, lines 37-46).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

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4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 3, 13, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shackelford (USPN 6,227,931 B1).

Regarding claim 3, Shackelford discloses a toy set, wherein a display is attached to a panel (Col. 11, lines 37-39). It is not explicitly disclosed that the display is attached to the panel with Velcro™. However, it would have been an obvious matter of design choice as to the method of attaching a display to a panel, wherein no stated problem is solved or unexpected result is obtained by prescribing a Velcro™ attachment.

Regarding claim 13, Shackelford discloses a toy set, comprising a display attached to a simulated wall, wherein the display is a liquid crystal display. It is not explicitly stated that the display includes light emitting diodes. However, it would have been an obvious matter of design choice as to choosing a specific type of display for displaying images, wherein no stated problem is solved or unexpected result is obtained by prescribing a light emitting diode display.

Regarding claim 24, Shackelford discloses a toy set, comprising a display attached to a simulated wall, wherein the display presents multiple images in association with a toy figurine. It is not explicitly disclosed that the toy set comprises a second display. However, it would have been an obvious to an artisan to modify the toy set described in Shackelford, by providing additional components, such as add-on modules (Col. 25, lines 31-36; Col. 26, lines 22-40) described in Shackelford, or any other component, in order to expand the toy set environment.

Claims 4 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shackelford (USPN 6,227,931 B1) in view of Shackelford (USPN 6,443,796 B1).

Regarding claim 4, Shackelford ('931) discloses a toy set, wherein display 93 is attached to a panel (Col. 11, lines 37-39), and wherein the panels comprise mating openings SP1-7 for electronically mounting add-on modules (Col. 22, lines 1-5; Col. 10, lines 57-67), wherein the

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add-on module is a device that is electronically dependent on controller 90 (See Col. 21, lines 56-59). Shackelford ('931) further discloses a panel having protrusions 73 and 74 for mating with toy pieces having protrusions 68 and 69. It is not explicitly disclosed that the display is attached to the panel by placing a protrusion in a mating opening. However, Shackelford ('796) teaches a toy set wherein display 53 is attached to panel 15 by placing a mating opening of the display in the protrusion of the panel (Col. 13, lines 55-65). Hence, in view of Shackelford ('796) it would have been obvious to modify the display described in Shackelford ('931) by providing mating openings in the display piece such that it can be attached to protrusions in a panel in order to provide a toy set that allows a child to place play pieces at certain locations in a construction set while providing an electrical connection to the play pieces in order to provide interactive responses.

Regarding claim 9, Shackelford ('931) discloses a toy set, wherein the stand-alone controller is adapted to receive inputs from controllers of add-on modules (Col. 25, lines 31-36; Col. 26, lines 22-40). It is not explicitly stated that controller 90 is adapted to receive inputs from a *personal computer*. However, Shackelford ('796) teaches a toy set comprising controller 17, which is adapted to receive inputs from personal computer 66 (See Fig. 2). Hence, in view of Shackelford ('796), it would have been obvious to an artisan to modify the controller described in Shackelford ('931) by adapting the controller to receive inputs from a personal computer in order to provide distribution of new game programs and other updates to the controller of the toy set such that the toy set never stales (See Shackelford '796, col. 8, lines 53-64).

Claims 10-11, 26, 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shackelford (USPN 6,227,931 B1) in view of Gabai et al. (USPN 6,352,478 B1; hereinafter Gabai).

Regarding claims 10, 26, and 30 Shackelford discloses a toy set comprising display 93, which is electrically connected to controller 90 for receiving image data. Shackelford further discloses various stand-alone structures, wherein controller 90 comprises a transmitting antenna to transmit data to the stand-alone structures to form an expanded environment. (See Fig. 19). It is not explicitly stated that the transmitting antenna transmits image data to a receiving antenna of the display. However, Gabai discloses a toy set wherein transmitter 1504 transmits image data to a receiving antenna 1514 coupled to a display (See Fig23). Hence, in view of Gabai, it would have been obvious to one of ordinary skill in the art to modify the method of distributing image data as described in Shackelford, by transmitting and receiving the image data via antenna, in order to provide a wireless link between toy set components and thereby form an expanded environment.

Regarding claim 11, the combination of Shackelford and Gabai discloses all of the claimed subject matter with the exception of explicitly disclosing that the receiving antenna of the display is *within a panel*. However, it would have been an obvious matter of design choice as to the placement of the receiving antenna of the display, wherein no stated problem is solved or unexpected result is obtained by prescribing a location within the panel.

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shackelford (USPN 6,227,931 B1), in view of Comiskey et al. (U.S. Patent No. 6,459,418; hereinafter Comiskey).

Shackelford discloses a toy set, comprising a display attached to a simulated wall, wherein the display presents images in association with a toy figurine. It is not specified that the images are displayed using *electronic printed ink*. However, Comiskey discloses a display that is powered and controlled using radio frequencies, wherein images are displayed using electronic printed ink (Column 5, lines 35-40), and wherein the display system is meant to be

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used anywhere it is useful to provided intermittent updates of information (See Abstract). In view of Comiskey, it would have been obvious to a person of ordinary skill in the art to modify the display system described in Shackelford, by displaying images using an electronic ink display, thereby providing a highly-flexible display that can be manufactured easily, consuming little power, which can be incorporated into a variety of applications (see Comiskey, column 2, lines 16-23).

Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shackelford (USPN 6,227,931 B1), in view of Lee et al. (U.S. Patent No. 6,102,397; herein after Lee)

Regarding claim 19, Shackelford disclose a toy set, comprising a detector to sense the location of a toy figurine, and to display image data on display 93 based on the detection of a toy figure position (Col. 14, lines 17-52). It is not specifically disclosed that the detector is a light sensor. However, Lee discloses a toy set, wherein optical detectors are utilized to determine identification of game pieces (column 4, lines 61-65). Hence, at the time of the invention, it would have been obvious to a person of ordinary skill in the art to modify the sensing means described in Shackelford, by providing optical sensors, in light of the teachings of Lee, in order to determine the position of a toy figurine and to further differentiate between each figurine, thereby producing an appropriate audio or visual response to the figurine position.

Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shackelford (USPN 6,227,931 B1) in view of Baxter (GB 2 271 724 A).

Regarding claim 22, Shackelford disclose a toy set, comprising a detector to sense the location of a toy figurine, and to display image data on display 93 based on the detection of a toy figure position (Col. 14, lines 17-52). It is not specifically disclosed that the detector is a

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pressure sensor associated with a bottom panel to sense a weight of the toy figurine. However, Baxter discloses a toy set, wherein pressure sensors are used to detect the weight of a toy figurine and to further differentiate between each figurine (see Abstract). It would have been obvious to a person of ordinary skill in the art to modify the sensing means described in Shackelford, by providing pressure sensors, in light of the teachings of Baxter, in order to determine the position of a toy figurine and to further differentiate between each figurine, thereby producing an appropriate audio or visual response to the figurine position.

Claims 23, 28, and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shackelford (USPN 6,227,931 B1) in view of Gilboa (U.S. Patent No. 5,853,327).

Regarding claims 23, 28, and 32 Shackelford disclose a toy set, comprising a detector to sense the location of a toy figurine, and to display image data on display 93 based on the detection of a toy figure position (Col. 14, lines 17-52). Shackelford further discloses controller 90, adapted to transmit and receive RF signals with multiple stand-alone character environments (Col. 26, lines 35-40). It is not explicitly stated that the toy figurines include a transponder. However, Gilboa discloses a toy set, wherein toy figurines include a transponder, and a detector that includes an antenna to detect a return signal from the transponder (column 3, lines 37-42; column 4, lines 15-29). Hence, it would have been obvious to an artisan to modify the detection mechanism described in Shackelford, by providing transponders within toy figurines, in order to sense the position of toy figurines without requiring line of sight, and to provide audio-visual interaction based on toy figurine position in a toy set environment.

Response to Arguments

Applicant's arguments with respect to claims 1-32 have been considered but are moot in view of the new ground(s) of rejection.

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Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

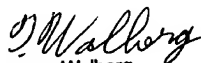
- Prinsen (USPN 5,825,347) – discloses a display device that interacts with a toy object.
- Danieli et al. (USPN 5,977,951) – disclose a receiving antenna coupled to a display.
- Vernall (US Patent Application Publication) – discloses a display device that interacts with a toy object via wireless connection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cameron Saadat whose telephone number is 703-305-5490. The examiner can normally be reached on M-F 8:00 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Teresa J Walberg can be reached on 703-308-1327. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

CS


Teresa Walberg
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Group 3700